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#16

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE TECH CENTER 1600/2900

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In re the application of:

MERRIL et al.

Group Art Unit: 1643

Serial Number: 08/879,139

Examiner: D. Wortman

OFFICE OF PETITIONS  
DEPUTY A/C PATENTS

Filed: June 19, 1997

Attorney Docket No. 108026-07004

For: ANTIBACTERIAL THERAPY WITH BACTERIOPHAGE GENOTYPICALLY  
MODIFIED TO DELAY INACTIVATION BY THE HOST DEFENSE SYSTEM

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT**

Commissioner for Patents  
Washington, D.C. 20231

Date: October 17, 2001

Sir:

Briefly put, a Petition to Withdraw Holding of Abandonment was filed in the above-identified application on June 21, 1999, after receiving a Notice of Abandonment for failing to respond to the Office Action mailed October 2, 1998. A Request for Status of Petition was filed August 11, 1999, to which no reply had been received.

The next communication received by the Applicants from the U.S. Patent and Trademark Office regarding the above-referenced application was a second Notice of abandonment for failure to respond to the Office Action re-mailed on January 10, 2000. This Notice of Abandonment was not mailed until March 27, 2001.

Further to a telephone request from Applicants' representative, Examiner Donna Wortman faxed a copy of the papers mailed on January 10, 2000 to Applicants' representative. Apparently, the Petition to Withdraw Holding of Abandonment had been granted on January 10, 2000. Accordingly, the Office Action dated October 2, 1999, was re-mailed on January 10, 2000, with a copy of the Decision, as well. Since these papers were never received by the Applicants, the application unintentionally went abandoned for a second time.

To review, on June 15, 1999, the examiner in this case, Donna C. Wortman, Ph.D., faxed a copy of the front page of an Office Action sent by the U.S. Patent and Trademark Office to the firm of Nikaido, Marmelstein, Murray & Oram LLP (referred to herein as "the firm") and indicated that a Notice of Abandonment was being sent out for failure to respond to the Office Action.

The facsimile transmission indicates that the Office Action was mailed from the USPTO on October 2, 1998. However, no such Office Action was ever received by the firm. Attached are copies of the Declarations signed by Ms. Debbie L. Orrison (the docket clerk for the firm on October 2, 1998), Ms. Monica Chin Kitts (the attorney responsible for the above application), Ms. Lorraine C. Barlow (the secretary for Ms. Kitts) and Mr. George E. Oram, Jr. (a partner in the firm), detailing the mail-handling and docketing procedures for the firm, and detailing the reasons why it is apparent that no Office Action for the above application was ever received by the firm.

On June 22, 1999, Applicants filed a petition requesting the withdrawal of the holding of abandonment. Applicants filed a Request for Status of Petition on August 11, 1999, and no reply was ever received. Following the submission of the petition and accompanying Declarations, Applicants' petition to withdraw the holding of abandonment was granted on January 10, 2000, and the Office Action was re-mailed. Applicants inexplicably did not receive a copy of this mailing either. The next communication from the United States Patent and Trademark Office that Applicant received was the second Notice of Abandonment.

Applicants' representative contacted Examiner Wortman shortly after receipt of the Notice of Abandonment to inquire as to its validity. Examiner Wortman transmitted via facsimile to Applicants' representative copies of the decision and pending Office Action. Applicants then filed this Petition to Withdraw the Holding of Abandonment.

It is noted that the mailing address of the firm was correctly listed as the correspondence address on the transmittal sheet filed with this application and on Office Actions mailed from the USPTO on April 6, 1998, and February 11, 1998. The effectiveness of the correspondence address is demonstrated by the fact that the April 6, 1998, and February 11, 1998, Office Actions were each received by the firm two days after being mailed from the USPTO.

It is also noted that any presumption that mail matter properly addressed, stamped and deposited in an appropriate receptacle is duly delivered is predicated on the fixed methods and systematic operation of the Postal Service, and that such a presumption can be rebutted. See Legille v. Dann, 544 F.2d 1 (CAFC 1976).

The effectiveness of the correspondence address has been demonstrated. Applicants' contention of non-receipt of the Office Action allegedly mailed October 2, 1998, is supported in the enclosed Declarations. Thus, it is respectfully submitted that the failure of the October 2, 1998 Office Action to reach the firm was not the fault of the firm in any way.

It is respectfully requested that the Office Action be re-mailed to the firm and that any holding of abandonment be withdrawn. See MPEP §711.02 and Delgar Inc. v. Schuyler, Commr. Pats, 172 USPQ 513 (D.D.C. 1971).

Any fees associated with this communication should be waived since the evidence submitted herewith shows that Applicants are in no way at fault for not responding to Office Action mailed October 2, 1998, or remailed January 10, 2000.

Should withdrawal from abandoned status not be granted immediately, this Petition should be considered to be a Petition to the Commissioner under 37 C.F.R. §§1.181-1.183, including a petition that all fees in connection therewith be waived because it is clear that Applicants are not at fault in this matter.

Should any such petition Under 37 C.F.R. §§1.181-1.183 not be immediately granted, this Request should be considered to be a Petition under (37 C.F.R. §1.137(a) or §1.137(b)), including a petition that all fees in connection therewith be waived because it is clear that Applicants are not at fault in this matter.

The Commissioner is hereby authorized to charge any fees associated with this communication to Deposit Account No. 01-2300.

Should the appropriate official of the U.S. Patent and Trademark Office have any questions, that official is requested to telephone Applicants' undersigned attorney.

Respectfully submitted,

ARENT FOX KINTNER PLOTKIN & KAHN, PLLC



D. Daniel Dzara, II  
Attorney for Applicants  
Registration No. 47,543

1050 Connecticut Avenue, N.W., Suite 400  
Washington, D.C. 20036-5339  
Tel: (202) 857-6000  
Fax: (202) 638-4810

DDD:kg

Enclosures: Facsimile copy of cover page of Office Action  
Copy of Declaration by Debbie L. Orrison  
Copy of Declaration by Monica Chin Kitts  
Copy of Declaration by Lorraine C. Barlow  
Copy of Declaration by George E. Oram, Jr.



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*Part of #16*

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DEPUTY A/C PATENTS

Examiner: D. Wortman

For: ANTIBACTERIAL THERAPY WITH BACTERIOPHAGE GENOTYPICALLY  
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Assistant Commissioner for Patents  
Washington, D.C. 20231

June 21, 1999

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The effectiveness of the correspondence address has been demonstrated. The applicants' contention of non-receipt of the Office Action allegedly mailed October 2, 1998 is supported in the enclosed Declarations. Thus, it is respectfully submitted that the failure of the October 2, 1998 Office Action to reach the firm was not the fault of the firm in any way.

It is respectfully requested that the Office Action be remailed to the firm and that any holding of abandonment be withdrawn. See MPEP §711.02 and Delgar Inc. v. Schuyler, Commr. Pats, 172 USPQ 513 (D.D.C. 1971).

Any fees associated with this communication should be waived since the evidence submitted herewith shows that the applicants are in no way at fault for not responding to the October 2, 1998 Office Action.

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The Commissioner is hereby authorized to charge any fees associated with this communication to Deposit Account No. 14-1060. A duplicate copy of this request is attached.

Should the appropriate official of the U.S. Patent and Trademark Office have any questions, that official is requested to telephone the applicants' undersigned attorney.

Respectfully submitted,

NIKAIDO, MARMELESTEIN, MURRAY & ORAM LLP

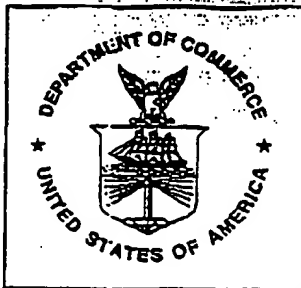
**SIGNATURE ON ORIGINAL**

Monica Chin Kitts  
Attorney for Applicant  
Registration No. 36,105

Atty. Docket No. P8026-7004  
Metropolitan Square  
655 Fifteenth Street, N.W.  
Suite 330 - G-Street Lobby  
Washington, D.C. 20005-5701  
(202) 638-5000  
MCK/TPC

Enclosures:

facsimile copy of cover page of Office Action  
Declaration by Debbie L. Orrison  
Declaration by Monica Chin Kitts  
Declaration by Lorraine C. Barlow  
Declaration by George E. Oram, Jr.



OCT 17 2001

**FAX**

TELECOPY/FACSIMILE TRANSMISSION

DATE: 6/15/99

PAGES: 3

(No. of pages including this cover sheet)

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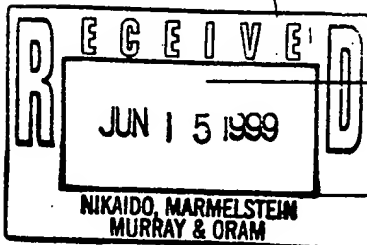
OCT 24 2001

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TO:

*Monica Chen-Kitts*

(ATTORNEY, AGENT, FIRM OR AGENCY)



08/879139

(ATTORNEY'S DOCKET NUMBER OR APPLICATION NUMBER)

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OCT 18 2001

(202) 638-4810

(FAX/TELECOPIER NUMBER)

OFFICE OF PETITIONS  
DEPUTY A/C PATENTS

FROM:

*Donna Wortman*

EXAMINER,

ART UNIT ~~1809~~ 1643

Group 1800 Fax Numbers

DIRECTOR'S OFFICE (703) 305-7230	BPS GROUP 1800 (703) 305-7230
ART UNIT 1801 (703) 308-3014	ART UNIT 1811 (703) 305-3014
ART UNIT 1802 (703) 308-4242	ART UNIT 1812 (703) 308-0294
ART UNIT 1803 (703) 308-4227	ART UNIT 1813 (703) 305-7939
ART UNIT 1804 (703) 308-0294	ART UNIT 1814 (703) 305-7401
ART UNIT 1805 (703) 308-0294	ART UNIT 1815 (703) 305-7939
ART UNIT <del>1806</del> <sup>1643</sup> (703) 305-7939	ART UNIT 1816 (703) 308-4242
ART UNIT <del>1807</del> <sup>1643</sup> (703) 305-7401	ART UNIT 1817 (703) 308-4242
ART UNIT 1808 (703) 305-7401	ART UNIT 1818 (703) 308-4242
ART UNIT 1809 (703) 308-0294	ART UNIT 1819 (703) 308-0294

EXAMINER'S OFFICE PHONE NUMBER: (703) 308-1032

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PLEASE CONTACT THE EXAMINER AT THE PHONE NUMBER ABOVE.ALL FAX MACHINES WILL BE AVAILABLE TO RECEIVE TRANSMISSIONS 24  
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DISTRICT OF COLUMBIA, IN WHICH CASE THE OFFICIAL DATE OF RECEIPT  
WILL BE THE NEXT BUSINESS DAY.



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark OfficeAddress: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, DC 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/27/97	08/15/97	MERKIL	PR026-7000

HM21/1002  
NIKALLO MARCELSTEIN MURRAY AND ORAM  
METROPOLITAN SQUARE  
655 FIFTEENTH STREET NW  
G STREET LOBBY SUITE 330  
WASHINGTON DC 20005-5701

EXAMINER  
WORTHINGTONART UNIT  
1543 PAPER NUMBER

DATE MAILED: 10/02/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

08/879,139

Applicant

Merril et al.

Examiner

Donna C. Wortman, Ph.D.

Group Art Unit

1643

☒ Responsive to communication(s) filed on Aug 10, 1998☐ This action is FINAL.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 31-40 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.☒ Claim(s) 31-40 is/are rejected.☐ Claim(s) \_\_\_\_\_ is/are objected to.☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.

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## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been received.☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152☒ Notice to Comply - SEQ

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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